

REMARKS

Claims 9, 15–20, and 31–85 are pending. Claims 1–8, 10–14, and 21–30 have been canceled. Claims 9, 15–20 and 31–61 stand rejected. Claims 62–85 are added with this response and Request for Continued Examination. Applicant respectfully requests reconsideration and allowance of all pending claims of this application.

The Office Action objects to the Abstract and requires correction of the Abstract. The Abstract has been amended, as described above.

The Office Action objects to claims 58 and 60 for identified informalities. Claims 58 and 60 have been amended to remove the informality by removing the commas in lines 6 and 7 of each claim.

Rejections Under § 112

Claims 19, 32, 40, 41, 46, 48, 54–57, and 59–61 stand rejected under 35 U.S.C. § 112 as assertedly being indefinite. Claims 19, 32, 40, 41, and 46, or claims from which they are dependent, have been amended to remove the asserted indefiniteness regarding the horizontal support member. Claim 48 has been amended to change its dependency, as suggested by the Examiner. Claim 54 has not been amended, because sufficient antecedent basis for “said plurality of walled recesses” can be found in the tenth line of claim 15, from which it depends.

The structure defined by the claimed flanges and notches in claims 55–57 and 59–61 is clearly shown in the revised Figures submitted herewith that reflect the detail included in the Figures as originally filed.

Additionally, claims 9, 15, 19, 44, 49, 58, and 60 have been amended to make editorial changes and not for any reasons relating to patentability.

Rejections Under § 102

Independent claims 9 and 60 stand rejected under 35 U.S.C. § 102(b) as assertedly being anticipated by U.S. Pat. No. 3,354,893 to Schmerl. The Office Action asserts that Schmerl ‘893 discloses the elements of these claims. Applicant respectfully traverses this rejection.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP § 2131. Where there are differences between the referenced disclosure and the claim, a rejection under § 102 is improper. *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 780 (Fed. Cir. 1985).

Claims 9 and 60 have been amended to recite that the support brackets are disposed downwardly on the seat with respect to the first, or horizontal, position of the seat. This is supported in the present application at page 4, lines 10 and 11 and in the Figures. Schmerl ‘893 does not disclose support brackets that are disposed downwardly with respect to the horizontal position of the seat.

Because of these differences between Schmerl ‘893 and claims 9 and 60, as amended, a rejection under § 102 is improper. Applicant respectfully requests withdrawal of the rejection of claims 9 and 60. Rejected claims 32–34, 40, 41, and 61 are dependent from independent claims 9 or 60 and are allowable as dependent from an allowable base claim.

Rejections Under § 103

Independent claims 15 and 58 stand rejected under 35 USC §103(a) as assertedly being unpatentable over U.S. Pat. No. 5,558,358 to Johnson in view of U.S. Pat. No. 4,438,603 to Durkan Jr. The Office Action asserts that Johnson ‘358 discloses all of the claimed elements except the limitation that the seat comprises an undersurface having a plurality of walled recesses. The Office Action states that Durkan, Jr. ‘603 “teaches that the practice of providing a seat with an undersurface having a plurality of walled recesses 30 was old and well known in the art at the time the invention was made.” Applicant respectfully traverses this rejection.

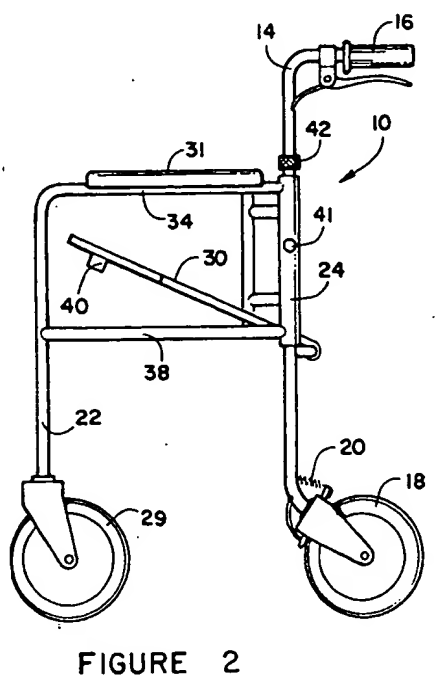
The Office Action fails to consider the cited references as a whole for what they teach. *See, e.g.*, MPEP § 2141.02. And the proposed modification, when considering the references as a whole, “would render the prior art invention being modified unsatisfactory for its intended purpose.” MPEP § 2143.01. The Office Action also fails to identify any motivation or expectation of success found in the references to make the proposed combinations. *See, e.g.*, MPEP § 2143.01. For each of these reasons, the Office Action does not establish a prima facie case of obviousness.

Each prior art reference and the claimed invention must be evaluated as a whole in determining obviousness. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143 (Fed. Cir. 1985). It is not permitted to first determine what it was the inventor did and then select only those facts from the prior art which may be modified to construct the invention from the prior art. *In re Shuman*, 361 F.2d 1008 (CCPA 1966). One “cannot pick and choose among the individual elements of assorted prior art references to recreate the claimed invention.” *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 859 F.2d 878, 887 (Fed. Cir. 1988). It is not proper that prior art references be cobbled together and “employed as a mosaic to recreate a facsimile of the claimed invention.” *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983).

The claims of the present application stand rejected based upon a cobbling together of various individual elements of prior art references. “It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” *In re Wesslau*, 353 F.2d 238, 241 (CCPA 1965); *see also Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448-49 (Fed. Cir. 1986). “[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed.” *Hartness Int’l, Inc. v. Simplimatic Eng. Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987).

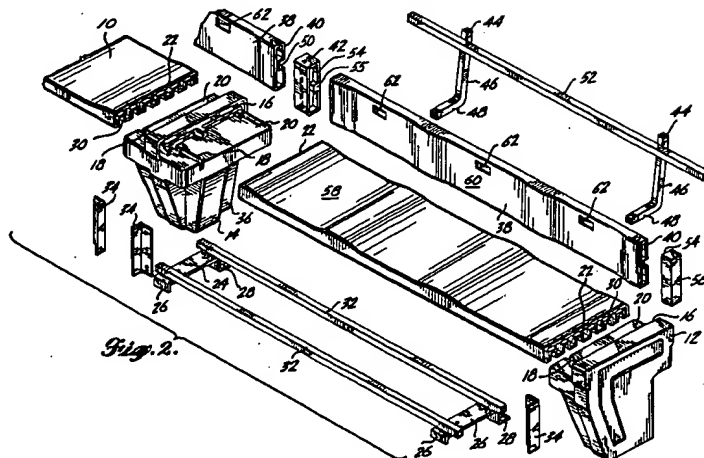
Johnson ‘358 “is directed to a portable and foldable patient transport device.” ‘358 column 1, lines 48–49. Durkan, Jr. ‘603 is directed to “plastic modular bench seating.” ‘603 column 1, line 7. The seating in Durkan, Jr. ‘603 is “plastic pieces which can quickly and conveniently be assembled together to form mass bench seating of any desired length . . . such as in a stadium.” ‘603 column 2, lines 24–29.

Figure 2 from Johnson ‘358 is provided below.



‘358 Figure 2

Figure 2 from Durkan, Jr. '603 is provided below:



'603 Figure 2

When the prior art references are considered as a whole, one of skill in the portable and foldable ambulatory device art would not look to the art of permanent, non-ambulatory bench stadium seating to solve problems relating to the ambulatory device.

The portions identified in Durkan, Jr. '603 by the Office Action as "walled recesses 30" are "a plurality of recessed channels 30." Column 4, line 15. Reinforcing bars 32 are welded to horizontal brackets 24 to fit into these recessed channels 30. Column 4, lines 14–20. These reinforcing bars "are captured in the channels on the underside of the seat section thus supporting and strengthening the unit." Column 2, lines 66–68. The channels 30 cooperate with these reinforcing bars that are permanently welded to stationary brackets in order to affix a bench seat, such as in a stadium, at a park, or at a bus stop. Column 2, lines 1–6. When considered as a whole, the seat structure of Durkan Jr. '603, teaches both the recessed channels in the underside of mass bench seating and the welded reinforcing bars to fit into the channels to support and strengthen the unit. There is no teaching in Durkan, Jr. '603 of recessed channels without accompanying welded reinforcing bars.

Johnson '358 teaches "a portable and foldable patient transport device which can be readily converted between a . . . wheelchair, a . . . patient walker and be folded into a small package for transport [or] storage." Column 1, lines 48–53. The seat in Johnson '358 is to be "pivotably attached . . . which allows the seat to be rotated toward the handles . . . when used as a walker or when prepared for storage." Column 2, lines 14–18. The invention claimed in Johnson '358 is "a convertible wheelchair/walker device which is convertible between a wheelchair, a walker, and a transport or storage configuration." '358 claim 1.

The channels identified by the Office Action in the Durkan, Jr. '603 seat structure cooperate with reinforcing bars permanently welded to a bracket. They cannot be excised from their function in the seat structure in Durkan, Jr. '603 to be applied in a piecemeal fashion to an unrelated structure in an ambulatory device. To combine this seat structure of Durkan Jr. '603, when considered as a whole, with Johnson '358 adds welded reinforcing bars between the frames of the Johnson '358 wheelchair/walker to cooperate with recessed channels. These welded reinforcing bars would eliminate the ability of the Johnson '358 device to accomplish its stated function to allow conversion of the device from a wheelchair to a walker and to be folded for

storage. The presence of welded reinforcing bars between the frames in the Johnson '358 walker/wheelchair would prevent folding the legs of the wheelchair to convert the wheelchair to the walker configuration. See, e.g., '358 Fig. 5.

The combination suggested by the Office Action would render the invention in Johnson '358 unsatisfactory for its intended purpose when the cited art is considered as a whole. Thus, the proposed combination is improper and does not establish a prima facie case of obviousness.

Moreover, the prior art must contain some suggestion or incentive that would have motivated one with skill in the art to modify a prior art reference to arrive at the present invention. *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988); *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Int., 1986). The prior art must also indicate a reasonable expectation of success to make the modifications, determined from the vantage point of one of ordinary skill in the art at the time the invention was made. Thus, there must be both a suggestion to modify and an expectation of success found in the prior art, not in the applicant's disclosure, to render an invention obvious. *In re Dow Chemical Company*, 837 F.2d 469, 473 (Fed. Cir. 1988). "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984); *see also In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). "[T]he inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed." *Hartness Int'l, Inc. v. Simplimatic Eng. Co.*, 819 F.2d 1100, 1108 (Fed. Cir. 1987).

Johnson '358 teaches that it is advantageous to "eliminate some structure to reduce weight," Column 1, line 36, so that the wheelchair/walker "is simple to convert between either use configuration or for storage by a person of limited strength." Column 2, lines 57–59. In contrast, the seat structure of Durkan, Jr. '603 adds significant structure. Each channel 30 has two vertical side walls and a recessed horizontal wall—each wall being of the same or similar thickness. See Durkan, Jr. '603 Figure 2, above. This adds significant structure to the seat. There is no motivation identified in the Office Action to add significant structure from the seat in Durkan, Jr. '603 to the wheelchair of Johnson '358 in contravention to the desirability stated in Johnson '358 to eliminate structure.

Also, as discussed above, such a combination would render the wheelchair of Johnson '358 unsatisfactory for its intended purpose. One of ordinary skill in the art would not be motivated to modify a structure so as to substantially impair its operation or intended purpose. *See, e.g., In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose). Moreover, Durkan, Jr. '603 does not teach, suggest, or even hint at using the stadium seating structure with a seat that hinges, as is taught in Johnson '358.

The Office Action has not established a *prima facie* case of obviousness to combine Durkan, Jr. '603 with Johnson '358 to arrive at the present invention, and excludes parts of the references necessary to the full appreciation of what these references fairly suggest to one of ordinary skill in the art. This is particularly true in light of the lack of any suggestion in the prior art to make such a combination and when the references are considered as a whole for what they teach. Neither reference teaches, suggests, or even hints at providing an "an ambulatory device" with "two side frames," a "brace," and a "seat [that] can be pivoted into at least two positions" with "a plurality of walled recesses" in an undersurface of the seat, as claimed in independent claims 15 and 58.

For at least these reasons, the rejection of independent claims 15 and 58 under 35 U.S.C. § 103(a) is improper, and Applicant respectfully requests that the rejection of claims 15 and 58 be withdrawn. Claims 16–20, 44–57, and 59 are dependent from claims 15 or 58 and are allowable as being dependent from an allowable base claim.

Dependent claims 16–20, 31–57, 59, and 61 of the present application are dependent from independent claims 9, 15, 58, or 60 and are allowable as dependent from an allowable base claim. These dependent claims also provide include further elements providing additional reasons for patentability.

Applicant has added claims 62 through 85 to alternatively describe the invention.

Appl. No. 09/977,122

Amdt. Dated May 20, 2004

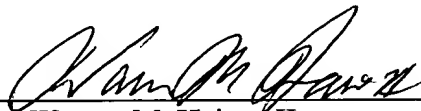
Reply to Office Action of November 20, 2003

Conclusion:

In view of the above remarks and amendments, it is submitted that claims 9, 15–20, and 31–85 are in condition for allowance. Prompt notice of such allowance is respectfully requested.

Respectfully submitted,

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